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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,266	05/29/2001	Christopher M. White	3382-56619	8058

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EXAMINER	
YIMAM, HARUN M	
ART UNIT	**PAPER NUMBER**
2611	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/870,266	WHITE ET AL.	
	Examiner	Art Unit	
	Harun M. Yimam	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05/29/2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *see Office Action*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 11/22/2004, 08/25/2004, 05/03/2004, 03/29/2004, 02/24/2003, 08/05/2002, 06/18/2002, 01/09/2002, and 10/05/2001 have been considered by the examiner.

The information disclosure statement filed 10/05/2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,8-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz (US 5,758,257).

Considering claim 1, Herz discloses a method of operating a video entertainment system comprising: generating profiles for plural users, said profiles being based, at least in part, on two video viewing habits (column 25, lines 7-13); presenting to a first viewer a listing of available programs that appeared favored by other viewers with similar profiles (column 5, lines 23-52 and column 46, lines 50-57); wherein the system can suggest to a viewer other programs based on similar viewers' preferences (column 22, line 64 – column 23, line 5).

As for claim 8, Herz discloses a method of operating a computer implemented interactive entertainment system (column 47, lines 26-29) comprising: logging entertainment selections of plural users (column 41, lines 26-28 and 33-36); generating affinity groupings based on similarities in the entertainment selections of plural users (column 15, lines 22-29); determining an affinity grouping for a first user based on the first user's entertainment selections (column 34, lines 31-32); and presenting to the first user available programs favored by members of the determined affinity grouping (column 47, lines 38-42).

With regards to claim 9, Herz discloses plural entertainment channels comprising broadcast television (column 48, lines 29-31) and at least one interactive entertainment channel (column 47, lines 38-42); and upon switching to an electronic programming guide, highlighting programs in the determined affinity grouping (column 45, lines 38-43).

Regarding claim 10, Herz discloses that the said presenting of available programs are presented in response to a viewer query (column 47, lines 26-29 and column 48, line 66 – column 49, line 1).

Considering claim 11, Herz discloses that the said presenting of available programs are presented autonomously by the interactive entertainment system (column 46, lines 43-57).

As for claim 12, Herz discloses a method of operating a computer implemented interactive entertainment system (column 47, lines 26-29) comprising: logging entertainment selections of plural users (column 41, lines 26-27 and 33-36); generating affinity groupings based on similarities in the entertainment selections logged (column 15, lines 22-29); polling a first user on a user interface to determine the first user's favorite entertainment (column 43, lines 3-6 and column 45, lines 59-63); determining an affinity grouping similar to the first user's favorite entertainment (column 34, lines 31-32); and presenting the first user a listing of available programs favored by members of the determined affinity grouping (column 47, lines 38-42).

With regards to claim 13, Herz discloses that upon returning to an interactive entertainment channel, the system automatically cycles through plural selections in the determined affinity grouping (column 48, lines 42-47).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) and Yoshinobu (US 5,734,444).

Regarding claim 2, Herz discloses a method of operating a video system (412—figure 4), the system including a video input (column 40, line 66 – column 41, line 4), a controller (column 45, lines 45-46), and a store (902—figure 9), the method comprising: monitoring a user's viewing habits to determine a favorite broadcast video program (column 14, lines 5-7 and column 42, lines 6-8).

Herz fails to disclose copying the video program to the store if the user is not viewing said program when broadcast. Herz also fails to disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast.

In analogous art, Yoshinobu discloses copying the video program to the store if the user is not viewing said program when broadcast. Yoshinobu further discloses that the user need not plan in advance to record a favorite program, because the favorite

program is automatically recorded if it is not viewed by the user when broadcast (column 24, lines 51-59).

It would have been obvious to one of ordinary skill in the art to modify Herz's system to include an automatic recording of the favorite program, as taught by Yoshinobu, for the benefit of not missing a favorite program when broadcast while watching another favorite program.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) and Yoshinobu (US 5,734,444), as applied to claim 2 above, in view of Hendricks (US 5,600,364).

Considering claim 3, Herz and Yoshinobu disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast.

Herz and Yoshinobu fail to disclose monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.

In analogous art, Hendricks discloses monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency

(column 38, lines 56-61); and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking (column 39, lines 3-6).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz and Yoshinobu to include determining a ranking of viewed broadcast video program by viewing frequency and storing plural programs in accordance with said ranking, as taught by Hendricks, for the benefit of accommodating the user's viewing preference.

7. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) and Yoshinobu (US 5,734,444), as applied to claim 2 above, in view of Alexander (US 6,177,931).

Considering claim 4, Herz and Yoshinobu disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast.

Herz and Yoshinobu fail to disclose defining plural viewing channels; on certain of said channels, presenting television programs for viewing; on at least one of said channels, presenting said copied video program for viewing.

In analogous art, Alexander discloses defining plural viewing channels (column 15, lines 47-48); on certain of said channels, presenting television programs for viewing

(column 30, lines 55-58); on at least one of said channels, presenting said copied video program for viewing (column 21, lines 50-54 and column 22, lines 29-33).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz and Yoshinobu to include presenting said copied video programs for viewing, as taught by Alexander, for the benefit of minimizing channel surfing.

Claim 5 is met by Herz, Yoshinobu, and Alexander. In particular, Alexander discloses listing the copied video in an electronic program guide associated with the system, together with a viewing channel on which the copied video can be viewed (column 30, lines 53-58).

Claim 6 is met by Herz, Yoshinobu, and Alexander. In particular, Alexander discloses that the copied video programs are maintained after viewing (the recorded programs may be set to be viewed once, daily, or weekly i.e. the program is maintained after the first viewing for the daily or the weekly viewing—column 21, lines 50-54).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) and Yoshinobu (US 5,734,444) in view of Alexander (US 6,177,931) as applied to claim 4 above, and further in view of Lazarus (US 5,652,613).

Considering claim 7, Herz, Yoshinobu, and Alexander disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast.

Herz, Yoshinobu, and Alexander fail to disclose that as space is needed in the video system, said copied video programs are overwritten in the following priority, first overwrite viewed copied video programs, then overwrite non-viewed copied video programs.

In analogous art, Lazarus discloses overwriting viewed copied video programs, then overwrite non-viewed copied video programs (column 2, lines 56-64, column 5, lines 22-26 and column 4, lines 21-29).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu, and Alexander to include a prioritized overwriting method, as taught by Lazarus, for the benefit of freeing storage space when the capacity is reached.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harun M. Yimam whose telephone number is 571-272-7260. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HMY

HAI TRAN
PRIMARY EXAMINER